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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,015	04/07/2000	Seth Haberman	2000522.122 US1	9448
28089	7590	01/31/2008	EXAMINER	
WILMERHALE/NEW YORK			BELIVEAU, SCOTT E	
399 PARK AVENUE			ART UNIT	PAPER NUMBER
NEW YORK, NY 10022			2623	
			NOTIFICATION DATE	DELIVERY MODE
			01/31/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	09/545,015	HABERMAN ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 October 2007.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 3-13 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1 and 3-13 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 31 October 2007 has been entered.

Response to Amendment

2. The declaration filed on 31 October 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the Ficco reference because the evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Ficco reference to either a constructive reduction to practice or an actual reduction to practice.

Applicants also submit that Exhibit B provides evidence of continued diligence from a date prior to the date of reduction to practice of the Ficco reference (23 March 2007) to the constructive reduction to practice of the invention (07 April 2007). The examiner respectfully disagrees. As noted in Item 9 of the declaration, work only appears to have been performed on seven of twelve business days and applicants state that the facts presented allude to the fact that work was performed by us during the critical period. The entire critical period covers sixteen days. Applicants do not account for their activities on 25 March 2000

– 28 March 2000 and 31 March 2000 – 03 April 2000, nor do they provide evidence as to their involvement during the critical period. What is meant by diligence is brought out in *Christie v. Seybold*, 1893 C.D. 515, 64 O.G. 1650 (6th Cir. 1893). In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958). An applicant must also account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue). It is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Accordingly, applicants are not believed to have demonstrated the required continued diligence throughout the entire critical period.

Response to Arguments

3. Applicant's arguments filed 31 October 2007 have been fully considered but they are not persuasive.

Regarding applicants' declaration to overcome the Ficco reference, as previously set forth, the evidence is considered to be insufficient. Accordingly, the Ficco reference is still applicable to the grounds of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 and 3-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Ficco (US Pub No. 2005/0166224 A1).

In consideration of claim 1, Figure 3 illustrates a “system for dynamically constructing a non-interactive personalized advertisement to be viewed by an intended audience”. The system comprises a “message campaign” associated with the coordinated effort to provide users with highly individualized broadcast advertisements (Para. [0005]). The ‘campaign’ includes an “advertisement template” represented by the received generic broadcast advertisement (Para. [0051]). The “advertising template” or generic broadcast advertisement “defines a framework for constructing said personalized advertisement [and the advertising template] comprises a plurality of media segment slots including video segment slots and

audio segment slots, wherein at least one video segment slot overlaps at least one audio segment slot” corresponding to the spatial/temporal locations of the audio/video information of the generic broadcast advertisement. The system comprises a “plurality of media segments including video segments and audio segments, each video segment selectable for insertion into at least one of said video segment slots of said for a same one of said video segment slots of said advertisement template, and wherein each audio segment is selectable for insertion into at least one of said audio segment slots of said advertisement template” (Para. [0028], [0036] – [0038], and [0082] – [0085]). As outlined in the process of Figure 5, the system further comprises an “advertisement assembly component” [30/80] that “responsive to user profile data of said intended audience . . . [is configured to apply] . . [a plurality of] . . . expert rules” associated with targeted advertisement techniques (Para. [0042]) “in order to get appropriate media segments from a database” [20] (Para. [0028], [0029], and [0066]) “and incorporate said appropriate media segments into said advertisement template, in order to assemble said personalized advertisement for said intended audience, said assembly performed without interaction by said intended audience” in so far as to the particular “assembly” simply occurs on-the-fly responsive to the particular display/receipt of a generic broadcast advertisement in a seamless manner (Para. [0053] – [0063]).

Claim 3 is rejected wherein the “said message assembly component also uses . . . temporal information in order to select appropriate media segments for assembling said personalized advertisement” (Para. [0047]).

Claim 4 is rejected wherein the “media segments are selected from the group including audio, video, background, animation, synthesized graphics and voice” (Para. [0061] – [0062]).

Claim 5 is rejected wherein “several of said media segments which corresponds to a same one of said media segment slots of said message template are of different lengths, and said message template appropriately adjusts said personalized advertisement based on a length of a selected one of said media segments” (Para. [0045] – [0047] and [0075]).

Claim 6 is rejected wherein the “personalized advertisement is assembled immediately before presentation to said intended audience” (Para. [0027]).

Claim 7 is rejected wherein “said user profile data of said intended audience is obtained from a plurality of user information data sources” (Para. [0039]).

Claims 8 and 9 are rejected wherein “said advertisement campaign includes a target entity profile . . . providing an indication of appropriate media segments for selected user profile data” and “providing an indication for selecting said intended audience from said user information data sources” (Para. [0042], [0043], [0069], and [0082] – [0087]).

Claim 10 is rejected as previously set forth in the rejection of claim 1. In particular, Figure 5 and its corresponding discussion disclose a “method for dynamically constructing a non-interactive personalized advertisement for viewing by an intended audience”. The method involves “obtaining user profile data for said intended audience” [200] and “selecting a message template” associated with the currently received generic broadcast advertisement which “defines a framework for constructing said personalized advertisement and includes a plurality of media segment slots [including video segment slots and audio segment slots

wherein at least one video segment slot overlaps at least one audio segment slot which] constitute said personalized advertisement” (Para. [0033] and [0061]). The system subsequently, “applies a plurality of expert rules to said user profile data and said message template, in order to select from a plurality of media segments including video segments and audio segments, appropriate media segments” [210] corresponding to different advertisement segments and/or features “for insertion into said plurality of media segment slots in said message template, wherein several of said video segments are selectable for a same one of said video segment slots of said message template”. The “personalized advertisement” is subsequently “assembled” [250] “using said message template and said selected media segments, without any interaction by said intended audience” and is “provided . . . in a format for delivery to said intended audience for viewing” such that the user simply tunes to a particular channel in order to seamlessly watch the individualized advertisement.

Claim 11 is rejected wherein “said advertising template and plurality of message segments are created as part of an advertising campaign” to provide highly individualized advertisements in order to increase the impact of the advertisement and increase sales volumes (Para. [0008]).

Claim 12 is rejected wherein “said steps of assembling said personalized advertisement and providing said assembled personalized advertisement is performed immediately before delivery to said intended audience” (Para. [0027]).

Claim 13 is rejected as previously set forth in the rejection of claims 1 and 10. In particular, Figure 5 and its corresponding discussion disclose a “method for dynamically constructing a non-interactive personalized advertisement for viewing by an intended

audience”. The method involves “obtaining user profile data for said intended audience” [200], “creating a plurality of media segments, including video segments and audio segments” [300] corresponding to distributed advertisement segments, “creating a message template” associated with the generic broadcast advertisement which “defines a framework for constructing said personalized advertisement and includes a plurality of media segment slots [including video segment slots and audio segment slots wherein at least one video segment slot overlaps at least one audio segment slot which] constituting said personalized advertisement” (Para. [0033] and [0061]). The system subsequently, “applies a plurality of expert rules to said user profile data and said message template, in order to select from a plurality of media segments including video segments and audio segments, appropriate media segments for insertion into said plurality of media segment slots in said message template, wherein several of said video segments are selectable for a same one of said video segment slots of said message template” [210]. For example, several of the particular segments could have selected for display during the display period depending upon the user. The “personalized advertisement” is subsequently “assembled” [250] “using said message template and said selected media segments, without any interaction by said intended audience” and is “provided . . . in a format for delivery to said intended audience for viewing” such that the user simply tunes to a particular channel in order to seamlessly watch the individualized advertisement.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Scott Beliveau
Primary Examiner
Art Unit 2623

SEB
January 24, 2008